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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,330	01/08/2001	Yueh-O Yu	JCLA6008	6728

23900 7590 11/29/2005

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EXAMINER	
VU, TUAN A	

ART UNIT	PAPER NUMBER
2193	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/756,330	YU, YUEH-O	
	Examiner	Art Unit	
	Tuan A. Vu	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 9/9/2005.

As indicated in Applicant's response, claims 1, 7, and 16 have been amended. Claims 1-29 are pending in the office action.

Claim Objections

2. Claims 1, 7, and 16 are objected to because of the following informalities: the group recited (see claim 1, 7 – bottom) as *"; as well as the personalized products are available ... and further comprises ... stored data*" is not constructed in otherwise more proper syntactical or grammatical form. The use of 'as well as' as a continuation of a previous limitation does not justify what has been added to the context created by 'as well as'; and this 'as well as' would be better understood if replaced by --wherein --. The verb used as in 'and further comprises a device' comes after the reciting of 'the personalized products' hence would need to be corrected to conform with the plurality of *products* as so understood; unless otherwise intended. Further, the phrase 'suitable of' can be readjusted to become 'suitable for'.

Likewise, in claim 16, the group recited as 'as well as the device for updating personalized products is ... available products ... without ability to access ... stored data' is not constructed with proper format that would be expected from the grammatical scope conveyed by 'as well as'. Besides, the newly added phrase ', *as well as'* (line 9 of claim) has not been underscored to indicate it as being part of an added limitation; and this is a deficiency with respect to CFR 1.121- c, 2; hence potentially can be treated as non-compliant amendment accordingly.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 7, and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 16 recites 'available products ... without ability to access the website so as to personalize the products through updating their functions and stored data'; claims 1, 7 recite 'available products ... without ability to access the website and further comprises[sic] ... updating their functions and stored data'. There is reciting of website connection and access of data therefrom and upload/storage of data therein in the specifications (specifications - pg. 11, 12); but nowhere is there any explicit mention of 'available products' directly in conjunction with 'without ability to access the storage device so to further provide functions updating ability. This 'without ability to access' limitation was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Thus, it will be treated as products with ability to upload/download data to and from a storage device.

Claims 2-6, 8-15, and 17-29 are also rejected for not remedying to the deficiencies of the base claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 7, and 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The reciting of 'and comprises' (claims 1, 7 second from last line) and 'stored data' (claims 1,7, 16 -last line of respective claims) is unclear (i) as to what is responsible for the act of comprising as set forth by 'and comprises' (re Claim Objections); and (ii) as to which data is being stored, e.g. in the storage device, in the device or in the personalized products. A broad interpretation of this unclear limitation will be applied.

Claims 2-6, 8-15, and 17-29 are also rejected for not remedying to the deficiencies of the base claims.

Correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a " useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

8. Claims 1-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the reciting of 'personalized products' or 'a device

for providing personalizing the products through updating ... stored data' (re claims 1, 7) OR 'device ... so as to personalize the products through updating their functions and stored data' (re claim 16) is interpreted in the context of the previously recited '...code suitable of being further designed and developed personally by a user of the personalized product at option of the user, and suitable of being uploaded back to the storage device' or 'website' (re claim 1, 7). Considering the limitation recited as 'suitable of', the device or personalized products as recited amount to depending on a action/limitation that is not clearly stated as having taking place (or been actualized) because the questionability issue derived from the use of 'suitable', i.e. such personalized products for 'providing the user with personalizing through updating and stored data' would yield no action leading to no result at all. If the user option to develop personalized code is still an option (e.g. no concrete action if the user decides not to take action) and the fact of uploading data back to the storage device is only a questionable event/entity that may or may not take place (or get executed) in view of 'suitable for', the 'device' or 'personalized products' as claimed would be also as indefinite as perceived via the reciting of 'option' and 'suitable'. In the eventuality that no action is being executed, the claims amount to no result being concretely generated; hence fail to fulfill the Practical Application test as set forth above. The claims are rejected for a non-practical application and a non-statutory subject matter.

Claims 2-6, 8-15, and 17-29 are also rejected for not remedying to the deficiencies of the base claims.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Note: 35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

10. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Wells et al., USPubN: 2003/0228912.

As per claim 1, Wells discloses a method for updating personalized products (e.g. *customized* - pg. 6, para 0043 – Note: target devices being verified with predetermined signature or identification, address – see para 0036, 0040, 0043 – combined with the inherent ownership of the gaming devices by a person – see *individual casino or similar locations* – is equivalent to product being personalized, i.e. providing specific programs to certain authenticated target devices owned by a person in whose name such target devices are being updated), comprising:

downloading a personalized program code from a storage device (e.g. *server 466* - Fig. 4);

receiving the personalized program code or data code by a transmission medium, and then transmitting the code to a programmable personalized product (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4; Fig. 1A-B); and

programming the personalized program code or data code received from said transmission medium into said programmable personalized product for updating the function or data therein (e.g. Figs. 1 – 5; pg. 6, para 0043-0046);

wherein the personalized program code or data code is suitable of being further designed and developed personally by a user (e.g. *changing features, upgrading, adding ... feature to a gaming terminal, standardization of programming* - pg. 6 para 0043 – Note: code data being changed or feature being added by game operators reads on data code suitable of being further developed by user; see *incorporated by reference* application 09/172787, or USPN 6,488,585: col. 5, lines 12-33 – Note: code being refurbished for release at a developers machine reads on designed by user of data code or personalized program; *repairing, updating* - col. 9, lines 27-40 -) of the personalized product at option of the user;

and is suitable of being uploaded back to the storage device (e.g. Fig. 1A; see para 0035: *incorporated by reference* -US Application: GAMING DEVICE IDENTIFICATION METHOD and APPARATUS, application 09/172787, now patented USPN: 6,488,585: col. 5, lines 12-33; *uploading* - col. 9, lines 27-40 – Note: code being refurbished for release at a developers machine and transferred for verification and storage to a central database reads on upload; and gaming regulating personnel sending game trouble report back to central jurisdiction reads on upload);

the personalized products are available products in the market and further comprise a device for providing the user with personalizing the products through updating their functions and stored data (e.g. *changing features, upgrading, adding ... feature to a gaming terminal,*

standardization of programming - pg. 6 para 0043; USPN: 6,488,585: col. 5, lines 12-33; *uploading* - col. 9, lines 27-40).

As per claim 2, Wells discloses a storage device being a hard disk, a CD-ROM (Fig. 4).

As per claim 3, Wells discloses personalized program code or data code being provided by a manufacturer (Fig. 4-5; *game manufacturers* - pg. 6, para 0043).

As per claim 4, Wells discloses that the personalized program code being developed and provided by a user (e.g. pg. 6, para 0043; *customer order 472* – Fig. 4; *information file* - Fig. 5; *laptop 128, game controller board* – Fig. 1A; pg. 3, para 0025, 0028 – Note: programming information enabling user to program and control the security of the download and activation of the downloaded reads on code being developed and provided by a user).

As per claim 5, Wells discloses a transmission medium being a personal computer and a hand-held device (e.g. Fig. 4; pg. 2, para 0017).

As per claim 6, Wells discloses transmission through an interface being a serial port interface (e.g. Fig. 4; *port* – pg. 3, para 0030 – Note: communications port from computer to gaming device implicitly discloses a serial/parallel port or USB port).

As per claim 7, Wells discloses a method for updating personalized products, comprising:

downloading a personalized program code from a web site (e.g. *network* – pg. 3, para 0030; *server 466* - Fig. 4 – Note: network central server computer and workstation for distribution of game products implicitly discloses communication between computers and web sites)

receiving the personal program code or data code by a transmission medium, and then transmitting the code to a programmable personalized product (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4; Fig. 1A-B); and

programming the personalized code or data code received from said transmission medium into said programmable personalized product for updating the function or data therein (e.g. Figs. 1 – 5; pg. 6, para 0043-0046);

wherein the personalized program code or data code is suitable of being further designed and developed personally by a user (e.g. *changing features, upgrading, adding ... feature to a gaming terminal, standardization of programming* -pg. 6 para 0043; see *incorporated by reference* application 09/172787, or USPN 6,488,585: col. 5, lines 12-33; *repairing, updating* - col. 9, lines 27-40) of the personalized product at option of the user;

and is suitable of being uploaded back to the website or storage device (e.g. Fig. 1A; see para 0035: *incorporated by reference* -US Application: GAMING DEVICE IDENTIFICATION METHOD and APPARATUS, application 09/172787, now USPN: 6,488,585: col. 5, lines 12-33; *uploading* - col. 9, lines 27-40 – Note: code being refurbished for release at a developers machine and transferred for verification and storage to a central database reads on upload; and gaming regulating personnel sending game trouble report back to central jurisdiction reads on upload);

the personalized products are available products in the market and further comprise a device for providing the user with personalizing the products through updating their functions and stored data (e.g. *changing features, upgrading, adding ... feature to a gaming terminal,*

standardization of programming - pg. 6 para 0043; USPN: 6,488,585: col. 5, lines 12-33; *uploading* - col. 9, lines 27-40).

As per claim 8, Wells discloses communication between the server and a transmission medium via a network of wireless or wired transmission system (e.g. *lan line* - pg. 3, para 0030; pg. 7, para 0051).

As per claim 9, Wells discloses a transmission system utilizing one modem (e.g. pg. 3, para 0030; link *324* – Fig. 3).

As per claim 10, refer to rejection of claim 5.

As per claim 11, Wells discloses a wireless link (e.g. pg. 3, para 0030).

As per claim 12, Wells does not explicitly disclose a wireless transmission system consisting of GSM, CDMA, GPRS; but discloses a wireless link and a handheld device (pg. 2, para 0017; pg. 3, para 0030), hence has implicitly discloses a wireless protocol and standard associated with the use of handheld device.

As per claim 13, Wells discloses transmission of personalized program code or data code to the programmable personalized product through a serial port or a USB port (Fig. 4; *port* – pg. 3, para 0030 – Note: communications port from computer to gaming device implicitly discloses a serial/parallel port or USB port).

As per claims 14-15, see claims 3-4 respectively.

As per claim 16, Wells discloses a device for updating personalized products, comprising:

an input/output end (e.g. Fig. 1A – Note: input to the local controller or laptop, output from the game controller board into features of the game, like video, audio output);

a programmable memory (e.g. *EEPROM* - pg. 3, para 0025), which is programmed with a personalized program code or data code through the input/output end; and

a personalized function circuit (e.g. *gaming terminal* - Fig. 1A) which updates functions and information according to the personalized program code or the data code stored in said programmable memory;

wherein the personalized program code or data code is suitable of being further designed and developed personally by a user (e.g. *changing features, upgrading, adding ... feature to a gaming terminal, standardization of programming* -pg. 6 para 0043; see *incorporated by reference* application 09/172787, or USPN 6,488,585: col. 5, lines 12-33; *repairing, updating* - col. 9, lines 27-40) of the personalized product at option of the user;

and is suitable of being uploaded back to the website or storage device (e.g. Fig. 1A; see para 0035: *incorporated by reference* -US Application 09/172787, now USPN: 6,488,585: col. 5, lines 12-33; *uploading* - col. 9, lines 27-40); wherein the device for updating personalized products is comprised in available products in the market as to personalize the products through updating their functions and stored data (e.g. *changing features, upgrading, adding ... feature to a gaming terminal, standardization of programming* - pg. 6 para 0043; USPN: 6,488,585: col. 5, lines 12-33; *uploading* - col. 9, lines 27-40).

As per claim 17, Wells discloses a transmission medium to receive and transmit the personalized program code or data code (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4).

As per claims 18-19, see claims 3-4, respectively.

As per claims 20 and 21, Wells discloses a control circuit for producing control functions (e.g. *laptop 128, game controller board* – Fig. 1A); and that the control circuit

generates voltage and control signal during programming the programmable memory (e.g. pg. 7, para 0053; pg. 3, para 0025; Fig. 2 – Note: checking communications correctness and using of laptop to control the download security checking/memory programming is equivalent to providing voltage and control signal during programming of gaming device).

As per claim 22, Wells discloses circuit for decoding a personalized program (e.g. Fig. 1B; Fig. 3 – Note: processor in gaming terminal with embedded processor is equivalent to having circuitry to decode instructions of downloaded personalized program)

As per claim 23, Wells discloses control circuit for transmission of personalized data code in the programmable memory (e.g. pg. 3, para 0028; Fig. 1a, 4).

As per claims 24-25, see Wells (Fig. 4, Fig. 1B; Fig. 3)

As per claim 26, Wells discloses personalized product being a gaming terminal.

As per claim 27, see Wells (*EEPROM* - pg. 3, para 0025).

As per claim 28-29, Wells discloses a program code and a data code within the programmable memory (e.g. pg. 6, *software information, installed programs* – pg. 0043; *data which defines* – para 0046 – Note: installed data or programs reads on program and data being part of the programmable EEPROM of terminals).

Response to Arguments

11. Applicant's arguments filed 9/9/2005 have been fully considered but they are not persuasive. Following are the Examiner's reply to the corresponding points raised in the Applicant's remarks.

Rejection under 35 USC 102(e):

(A) Applicant has submitted that the Wells does not teach 'transmission medium' as claimed from claims 1 and 7 (Appl. Rmrks, middle para - pg. 11). The Fig. 1A and 1B as put forth in the rejection has shown that a transmission medium exists between a server and any recipient gaming machine. And the argument on the Examiner's analogizing a website means of transmission to a medium of transmission represented by Well's local server does not justify why a medium via which Wells distributes its gaming software to a network of game terminal would be any different of a so-called transmission medium as proffered; hence the argument is non persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In other words, Applicant appears to convey that by claiming 'transmission medium' this medium has to be of a particular form or type and what is recited by Well's server/terminal transmission system would not read on that form. The claim is not specific about what this medium particularly amounts to. Further, since the *download* limitation has been addressed earlier in the claim, inter alia, the mere fact of downloading by Wells reads on a transmission medium being inherent to Well's download system.

(B) Applicant has submitted that the invention objectives are to 'update functions and data of available products in the market ... comprising a device for updating functions' (Appl. Rmrks, pg. 13, bottom, pg. 14, top). The claims as analyzed in the USC 112 rejection and USC 101 rejection have been detected as to possess improprieties, and lack of definiteness or statutory subject matter. For example, the 'no ability to access the internet' limitation has no explicit teaching from the specifications, as set forth in the USC 112, 1st paragraph. Moreover, the so-

called 'personalized products' or 'device ... comprised in available products' amount to being founded on an user's option to provide update of code or stored data, such code being barely suitable; and this option which is the foundation of an entity 'suitable for' operating or actualizing the purposes of the claimed device or personalized products clearly put the viability of such device or products into doubt, or leave the realization of such products at a strong improbable state; and this has been as set forth in the USC 101. Based on the broadest interpretation to substitute for the deficiencies of the invention as recited in view of the specifications, the claim amount to interpretation as set forth in the above rejection; and the cited parts of Wells as well as those from incorporated patent 6,488,585 have met all the limitations.

Hence, the arguments are not persuasive. Therefore, the claims stand rejected as set forth in the Office Action.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 (for non-official correspondence – please consult Examiner before using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT
November 18, 2005

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